

REMARKS

With this Preliminary Amendment, an amendment for “related U.S. application data” is added to the Specification, claims 40-64 are cancelled without prejudice, and claims 65-92 are added. Claims 41-45, 47, 49-51, 53-57, 59 and 61-63 are being prosecuted in U.S. Patent Appl. Ser. No. 10/441,556.

New claims 65-92 are presented by Applicants for consideration. Applicants respectfully submit that none of the cited prior art, alone or in combination, disclose, teach or suggest the elements and limitations of independent claims 65 or 80. Additionally, none of the cited prior art discloses, teaches or suggests the additional limitations of dependent claims 66-79 or 81-92, which depend from claims 65 and 80, respectively.

In particular, Cooper (U.S. Patent No. 5,997,422), alone or in combination with the other cited prior art, does not teach, suggest or disclose the limitations of either independent claim 65 or independent claim 80. Specifically, regarding claim 65, Cooper does not disclose, teach or suggest a game ball including a casing having a laced region, and a lacing coupled to, and outwardly extending from, the laced region, wherein the lacing having an exposed surface comprised of a compressible, resilient, and tactile outer material having a modulus of elasticity of between 14 and 170 kg/cm² and a tensile strength between 100 and 650 kg/cm². Regarding claim 80, Cooper does not disclose, teach or suggest a game ball including a casing having a laced region, and a lacing coupled to, and outwardly extending from, the laced region, wherein the lacing having an exposed surface comprised of a compressible, resilient, and tactile outer material having a modulus of elasticity of between 14 and 170 kg/cm².

In contrast, Cooper discloses a waterproof game ball including an elastically stretchable outer casing surrounding a bladder. The casing is formed from four elastically stretchable flexible panels, wherein each panel is formed of layers of substantially water-impervious material. The panels are sealed together, preferably in a waterproof manner, along

marginal edge portions of the panels to define four equally spaced seams. The marginal edges of the panels protrude from the seams and extend inward into the football and are in contact with the inflated bladder. A portion of one paragraph of the disclosure of Cooper listed below refers to the lacing on a football.

Lacing 16 extends through the holes 12 and 14, crossing the gap 2c, and ties the panels 8 and 9 together in a waterproof manner to prevent exposure of the bladder 4 to the outside of the football and to substantially totally prevent liquid from entering the interior of the football. When a player throws the football 2, the player grasps the football with his fingertips on the lacing 16. Thus the lacing 16 further enhances traction which improves the throw of the football 2 while maintaining perfect balance of the football. The preferred material for the lace 16 is, for example, a suitable plastic. Col. 4, lines 1-11.

A suitable lacing for a football must possess at least two characteristics. First, the lacing must provide the user with raised surfaces upon which the user can place his or her fingertips for facilitating throwing of the football. Second, the lacing must be formed of a material, or materials, having sufficient structural integrity, strength and durability to properly retain the pressurized bladder within the football and to withstand the impacts, stress and wear applied to a football during normal use.

In the above-listed excerpt, Cooper refers to the inherent raised surfaces of the lacing resulting from the outward extension of the lacing from the casing of the ball, which provide the well-known functional advantage of facilitating the ability of a user to throw the football in a balanced manner. The contact of a user's fingertips with these raised surfaces of the lacing enables the user to impart greater force and rotation to the ball when making a throw, thereby enabling the user to throw in an accurate balanced fashion.

In the context of a football, one of ordinary skill in the art at the time of the filing of Cooper, would interpret the term "plastic" to refer to the wide variety of non-resilient, non-compressible, durable plastic materials commonly used in the market place, because a lacing for a football formed solely of plastic must have sufficient strength to properly

retain the pressurized bladder within the casing of the ball, and to maintain its structural integrity under the repeated impacts, loads and wear and tear associated with routine play. Cooper does not disclose, suggest or teach the use of a lacing material that is compressible, resilient and tactile, and, in particular, the use of a material made solely of an inherently less durable compressible plastic. No reasonable expectation of success would exist for a lacing of a football formed solely of less-durable, compressible and resilient plastic. Cooper, in fact, teaches away from the use of a less durable material. One of the objects of the invention of Cooper is to provide a durable waterproof game ball. "[T]he inventive waterproof game ball ... is highly durable and resistant to structural or performance degradation." Col. 6, lines 28-30. Only a lacing formed of a harder, durable plastic is consistent with the teachings of Cooper.

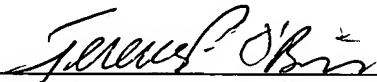
Further, Cooper is void of any suggestion, disclosure or teaching of an outer material of a lacing that is compressible, resilient and tactile, and has a modulus of elasticity of between 14 and 170 kg/cm² and a tensile strength between 100 and 650 kg/cm². Cooper is completely silent with respect to any modulus of elasticity values or tensile strength values. Further, the general knowledge of one of ordinary skill in the art at the time of the filing of Cooper would not suggest such an outer material for a lacing. An attempt to produce such a lacing solely of a less-durable, compressible, resilient plastic would not be consistent with the lacing application which requires a construction that is highly durable, capable of retaining a pressurized bladder and capable of maintaining its structural and performance integrity under repeated impacts, loads, and wear. Moreover, Cooper must be viewed without the benefit of impermissible hindsight afforded by the present claimed invention.

Accordingly, it is respectfully submitted that Cooper, alone or in combination with the cited references, does not teach, suggest or disclose the game ball of claims 65 or 80. Additionally, it is respectfully submitted that Cooper, alone or in combination with the cited references, does not teach, suggest or disclose the game ball of dependent claims 66-79 or 81-92, for at least the same reasons.

The Examiner is invited to telephone the undersigned at (847) 472-6104 to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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